

Amendments to the Drawings

Please amend all the figures by replacing the existing drawing sheets containing the existing figures with the replacement drawing sheets containing the amended figures as indicated in attached Appendix A.

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REMARKS

The Office Action dated March 16, 2010 has been received and carefully considered. Claims 1-58 are pending in the application. All claims have been amended. No new matter is added by this Amendment. Applicant believes that the application is now in condition for allowance and notice thereof is respectfully requested.¹

Examiner Interview

Applicant thanks the Examiner for the telephone interview on March 10, 2010, during which the Information Disclosure Statement (IDS) submitted on December 30, 2004 was discussed. Applicant's representative explained that the IDS included references that were unrelated to the present application and should not be considered.

Pending Objections

The Office Action appears to object to drawings filed on July 15, 2009. *See* Office Action, page 1. Applicant clarifies that drawings were not filed on July 15, 2009. However, in order to advance prosecution, Applicant submits a replacement set of drawings attached as Appendix A. Accordingly, Applicant respectfully requests that the objection to the drawings, if any, be withdrawn.

¹ As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions in the Office Action or certain requirements that may be applicable to such rejections (*e.g.*, assertions regarding dependent claims, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

In addition, the Office Action objects to claim 23 based on informalities. *See* Office Action, page 2. More specifically, the Office Action asserts that “code should not be capitalized.” *Id.* Applicant respectfully submits that the amendments to the claims overcome the objection to claim 23. Accordingly, Applicant respectfully requests that the objection to claim 23 be withdrawn.

Pending Rejections

Claims 1-58 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claims 1-58 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

Claims 1-58 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over US Patent No. 6,609,050 to Li *et al.* (“Li”) in view of US Application Publication No. 2002/0091706 to Anderson *et al.* (“Anderson”).

Response to Rejections Based on 35 U.S.C. § 112, Second Paragraph

The Office Action rejects claims 1-58 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. *See* Office Action, pages 2-3. More specifically, the Office Action asserts that “Applicant should positively recite intended method steps and remove instances of intended use when Applicant is trying to provide claim scope.” *Id.* Applicant respectfully submits that the amendments to the claims overcome the rejection to the

claims under 35 U.S.C. § 112. Accordingly, Applicant respectfully requests that the rejection to claims 1-58 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Response to Rejections Based on 35 U.S.C. § 101

The Office Action rejects claims 1-58 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. *See* Office Action, page 3. More specifically, the Office Action asserts that “Applicant’s [claims are] not drawn to patent-eligible subject matter because [they fail] the ‘machine or transformation test.’” *See* Office Action, page 4. Applicant respectfully submits that the amendments to the claims overcome the rejection to the claims under 35 U.S.C. § 101. Accordingly, Applicant respectfully requests that the rejection to claims 1-58 under 35 U.S.C. § 101 be withdrawn.

Response to Rejections Based on 35 U.S.C. § 103(a)

The Office Action rejects claims 1-58 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Li in view of Anderson. To the extent these rejections might apply to the pending claims, Applicant respectfully traverses these rejections and requests reconsideration thereof for reasons set forth below.

Under 35 U.S.C. § 103, all claim limitations must be taught or suggested in the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP § 2143 reinforces this principle: “[T]he prior art reference (or references when combined) must teach or suggest all the claim limitations.”

Li is directed to a system for managing vehicle repairs at a vehicle repair facility. The Li system interacts with a customer to diagnose repairs that may be needed to fix a malfunction in

the customer's vehicle. The Li system also interacts with a service technician to prepare work orders associated with repairing the customer's vehicle, schedule repair times to repair the customer's vehicle, and determine whether repairs will be covered under a manufacturer's warranty. Likewise, Anderson is directed to a vehicle history and personalization system that tracks the service history and warranty coverage associated with a customer's vehicle.

In contrast, an embodiment of the claimed invention is directed to a method for *preparing an original equipment manufacturer (OEM) warranty claim associated with a vehicle*. That is, an embodiment of the claimed invention is directed to at least preparing a warranty claim on the OEM's standard form using information stored in a computer accessible database.

Claim 1, as amended, recites in pertinent part "compiling ... a computer accessible database, said database listing a plurality of vehicles on which warranty claims are prepared for a user, *listing all parts for each vehicle so listed, listing the original equipment manufacturers standard repair time allowed for repair for each such part, listing the proper failure and cause codes required by the original equipment manufacturer for each such part, and containing the original equipment manufacturer's standard form for a warranty claim*" Applicant respectfully submits that neither Li nor Anderson, taken alone or in combination, teaches or suggests these limitations.

The Office Action asserts that "Li discloses ... listing all parts for each vehicle so listed." See Office Action, pages 4-5. In support of this assertion, the Office Action cites to several portions of Li. *Id.* These portions of Li, however, completely fail to teach or suggest "listing all parts for each vehicle so listed," as presently claimed. At most, Li discloses displaying repair services that may be performed on a vehicle in a service menu to help a service associate

determine costs associated with a particular work order. *See* Li, Figure 23; column 8, lines 6-14. This disclosure of Li, however, completely fails to teach or suggest “listing all parts for each vehicle,” as presently claimed. Indeed, Li only discloses a limited number of general repair services that may be performed for any vehicle. Accordingly, Applicant respectfully submits that the applied references fail to teach or suggest “listing all parts for each vehicle so listed,” as presently claimed.

The Office Action also asserts that “Li discloses ... listing the original equipment manufacturers standard repair time allowed for repair for each such part.” *See* Office Action, pages 4-5. In support of this assertion, the Office Action cites to several portions of Li. *Id.* These portions of Li, however, completely fail to teach or suggest “listing the original equipment manufacturers standard repair time allowed for repair for each such part,” as presently claimed. At most, Li discloses a standard cost in hours to service a vehicle:

A work order is entered into the interface, and the standard number of hours and costs associated with performing the work is retrievable from the databases of the present invention so that a standard cost in hours to service the vehicle can be used by service shots throughout the entire country.

See Li, column 7, lines 30-35. This limited disclosure of Li, however, does not meet “listing the original equipment manufacturers standard repair time allowed for repair for each such part,” as presently claimed. Indeed, this disclosure of Li cannot meet “listing the original equipment manufacturers standard repair time allowed for repair for each such part” because Li completely fails to teach or suggest “listing all parts for each vehicle so listed,” as discussed above. That is, Li cannot disclose “listing the original equipment manufacturers standard repair time allowed for repair for each such part” because Li only provides standard hours on a per work order basis, as opposed to, a per part basis. Furthermore, Li completely fails to disclose an “original equipment manufacturers standard repair time allowed.” Accordingly, Applicant respectfully

submits that the applied references fail to teach or suggest “listing the original equipment manufacturers standard repair time allowed for repair for each such part,” as presently claimed.

The Office Action admits that “Li does not expressly disclose the database containing the original equipment manufacturer’s standard form for a warranty claim.” *See* Office Action, page 6. In an attempt to cure this admitted deficiency, the Office Action asserts that “Anderson teaches a program that can prepare a warranty claim on the original equipment manufacturer’s standard form for a warranty claim.” *Id.* In support of this assertion, the Office Action cites to paragraph 32 of Anderson. Paragraph 32 of Anderson, however, only discloses a user accessing Li’s system to retrieve warranty information (*e.g.*, the type of warranty, the date the warranty expires) associated with a vehicle:

A user may access service and warranty information by using link 320 which leads to a services and warranty screen depicted in Fig. 4. Services and warranty screen 400 may include a plurality of links including but not limited to a service link 410 which provides service details, maintenance logs, and any recall information relating to the user’s vehicle. Accordingly, a user who is not aware of a product recall on a part of the vehicle may proceed to service link 410 and be apprised of such information. Services and warranty application 400 also includes a warranty link 420. Proceeding through link 420 will provide a user with specific warranty information regarding the user’s vehicle. Accordingly, a user need not keep paper records of warranty information, the warranty information being retrievable and accessible on-line.

Anderson, paragraph 32. Indeed, paragraph 32 completely fails to even mention an original equipment manufacturer’s standard form, let alone, “a computer accessible database ... containing the original equipment manufacturer’s standard form for a warranty claim,” as presently claimed. Accordingly, Applicant respectfully submits that the applied references fail to teach or suggest “a computer accessible database ... containing the original equipment manufacturer’s standard form for a warranty claim,” as presently claimed.

Claims 10, 17, and 23 contains similar recitations as claim 1 and is allowable for at least similar reasons as discussed above regarding claim 1. Claim 10 recites, in pertinent part,

“compiling ... a computer accessible database, said database listing a plurality of vehicles on which warranty claims are prepared for a user, listing all vehicle systems for each vehicle so listed, listing all parts for each vehicle system so listed, listing the original equipment manufacturers standard repair time allowed for repair for each such part, listing the proper failure and cause codes required by the original equipment manufacturer for each such part, and containing the original equipment manufacturer's standard form for a warranty claim.” Claim 17 recites, in pertinent part, “compiling ... a computer accessible database, said database listing a plurality of vehicles on which warranty claims are prepared for a user, listing all vehicle systems for each vehicle so listed, listing all parts for each vehicle system so listed, listing the original equipment manufacturers standard repair time allowed for repair for each such part, listing the proper failure and cause codes required by the original equipment manufacturer for each such part, containing the original equipment manufacturer's standard form for a warranty claim, listing all bills of materials for the vehicles, and listing all parts set forth in each of said bills of materials for the vehicles.” Claim 23 recites, in pertinent part, “compiling ... a computer accessible database containing information on a group of vehicles, said information including a listing of the vehicles, a listing of parts used in the assemblage of each such vehicle, and items of information including images related to each such part, where each vehicle is linked to the list of parts used in the assemblage of that vehicle, and where each part is linked to items of information related to that part via a single code linked to that part and to the items of information related to that part.” As discussed above with respect to claim 1, the applied references fail to teach or suggest these limitations.

Applicant respectfully submits that the applied references fail to teach or suggest these limitations. Therefore, Applicant respectfully submits that the rejection of independent claims 1,

10, 17, and 23 and all claims dependent thereon under 35 U.S.C. § 103(a) should be withdrawn for at least these reasons. Accordingly, Applicant respectfully requests that the rejection of independent claims 1, 10, 17, and 23 and all claims dependent thereon under 35 U.S.C. § 103(a) be withdrawn.

Conclusion

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.